

Application No. 09/334,040
Page 5

REMARKS

Claims 1-7 and 9 were examined. Claims 1, 3, and 9 are rejected. Claim 2 is objected to. Claims 4-7 are allowed.

Applicants amend claims 1 and 9 and reserve the right to prosecute the former claims in a divisional or continuation application. Applicants respectfully request reconsideration of pending claims 1-3 and 9, as amended, in view of at least the following remarks.

I. Allowable Subject Matter

Applicants note with appreciation that claims 4-7 are allowed and claim 2 is indicated to contain allowable subject matter.

II. Claims Rejected Under 35 U.S.C. §112

The Patent Office rejects claim 9 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification. Specifically the Patent Office states that the limitation "watching" in line 4 should be changed because "watching a voltage change is a new technique, therefore, it must be disclosed in detail in the specification." Although Applicants respectfully disagree, Applicants have amended claim 9 in order to expedite prosecution of the application. Specifically, Applicants replace the term "watching" with the term "monitoring" as supported on page 3 of the specification as filed.

The Patent Office rejects claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite because claim 9 recites the limitation "the protocol" in line 6, which has insufficient antecedent basis. Applicants amend claim 9 to replace the limitation "the protocol" with the limitation "the mode". Hence, Applicants assert that amended claim 9 is proper and respectfully request that the Patent Office withdraw the rejection of claim 9 under 35 U.S.C. §112.

Application No. 09/334,040
Page 6

III. Claims Rejected Under 35 U.S.C. §102

The Patent Office rejects claim 9 under 35 U.S.C. §102(b) as being anticipated by European Patent Application No. DE 03917482 filed by Eilts, et al. ("Eilts"). It is axiomatic that to be anticipated every element of the claim must be disclosed within a single reference. Applicants respectfully disagree with the rejection above and submit that amended independent claim 9 is allowable for at least the reason that Eilts does not describe "detecting in a first device of the pair from the cable a mode of the second device by monitoring an unused contact of a cable connector for a predetermined voltage level; and driving the first device into the mode detected," in accordance with Applicants' amended claim 9. Specifically, according to claim 9, for example, a first device may be driven to the mode of a second device detected by monitoring an unused contact of a cable connector.

On the other hand, Eilts describes air conditioning controllers connected together via a redundancy line so that the failure of one controller causes a voltage change on the redundancy line which results in a further device being switched on to maintain operation of the system. Thus, Eilts describes a redundancy line designed to be connected to the air conditioning controllers so that failure of one controller can be detected via the redundancy line to cause another controller to be switched on.

However, the Patent Office has not identified, and Applicants have been unable to find any description in Eilts of an unused contact of a cable connector, or of driving the first device into the mode of the second device detected, as required by amended claim 9. Specifically, the unused contact of a cable of Applicants' claim 9 is not described by a redundancy line designed to provide a voltage change on the redundancy line if a controller of Eilts fails. Moreover, claim 4's driving a first device into the mode of a second device detected, is not described by the switching on of a device to maintain operation of the system when the failure of a controller is detected of Eilts. Hence, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claim 9 under 35 U.S.C. § 102(b) as being anticipated by Eilts for at least the two reasons identified above.

Application No. 09/334,040
Page 7

IV. Claims Rejected Under 35 U.S.C. §103

The Patent Office rejects claims 1 and 3 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,553,117 to Armistead et al. ("Armistead").

A. Amended Independent Claim 1

To render a claim obvious all elements of that claim must be taught or suggested by at least one properly combined reference. Applicants respectfully disagree with the rejection above and submit that amended independent claim 1 is allowable for at least the reason that the cited references do not teach, suggest, or describe "an interface module having a network interface and to detect a voltage at an unused contact to identify a networking protocol for which the apparatus should be configured," in accordance with Applicants' amended independent claim 1. According to amended claim 1, for example, an interface module may monitor an unused contact of a network interface cable for a voltage level which corresponds to the identification of a networking protocol.

On the other hand, Armistead suggests that a control processor reconfigure a system from one networking protocol to another while attempting to establish a lock on the signal of a signal line for that protocol, and moving on if a lock is not established. Thus, in Armistead, the control processor selects a networking protocol, configures the system to that protocol, and then attempts to establish a lock on a signal line's incoming signal in accordance with that protocol. (See Armistead abstract; column 2 lines 19-35)

However, the Patent Office has not identified and Applicants have been unable to find any suggestion or teaching in Armistead of detecting a voltage at an unused contact to identify a networking protocol. Therefore, the network interface to detect a voltage at an unused contact to identify a networking protocol of Applicants' amended independent claim 1 is not taught or suggested by the switching between protocols and attempting to establish a lock of Armistead. Hence, Applicants respectfully request that

Application No. 09/334,040
Page 8

the Patent Office withdraw the rejection of amended independent claim 1 under 35 USC § 103(a) as being unpatentable over Armistead.

B. Dependent Claim 2

Applicants submit that dependent claim 2, being dependent upon allowable base amended claim 1, is patentable over the cited references for at least the reasons explained above. Thus, Applicants respectfully request that the Patent Office withdraw the rejection of dependent claim 2 under 35 USC § 103(a) as being unpatentable over Armistead.

C. Amended Independent Claim 3

Applicants also respectfully disagree with the rejection above and submit that amended independent claim 3 is allowable for at least the reason that the cited references do not teach, suggest, or describe the second networking device "driving itself into the first networking protocol." As described above with respect to amended independent claim 1, Armistead teaches a control processor switching to a networking protocol and then attempting to establish a lock in accordance with that switched to protocol. Consequently, the system of Armistead is already implementing the networking protocol of the signal the system locks onto. Therefore, the second networking device identifying the first networking protocol and then driving itself into the first networking protocol of Applicants' amended independent claim 3 is not taught by the switching to a networking protocol and then establishing a lock for that switched to protocol of Armistead. Hence, for this reason, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claim 3 under 35 USC § 103(a) as being unpatentable over Armistead.

Next, in the rejection of claim 3, the Patent Office states "Since it is well known that 75 Ohms standard implies E1 unbalanced standard, which uses BNC coaxial connector, 100 and 120 Ohms standards imply T1 and E1 balanced standard, which uses RJ 48 connector. A skilled artisan would have been motivated to use appropriate

Application No. 09/334,040
Page 9

connector at two ends of the cable (all BNC, RJ 48 or BNC at one end and RJ 48 at the other end) depending on the standard used by the system at that end." Applicants traverse the assertion quoted above and request that the Patent Office cite a reference in support of this position in accordance with MPEP § 2144.03. Hence, for this second reason, Applicants respectfully request that the Patent Office withdraw the rejection of amended independent claim 3 as being unpatentable over Armistead.

Application No. 09/334,040
Page 10CONCLUSION

In view of the foregoing, it is believed that all claims now pending are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on July 21, 2003, Applicant respectfully petitions the Commissioner for a one (1) month extension of time, extending the period for response to November 21, 2003. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$110.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(2) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: October 31, 2003



Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on October 31, 2003.


Jean Svoboda